REMARKS

The present invention discloses an apparatus and method for placing a call from a mobile phone to a telephone number that is not found among a list of frequently called telephone numbers stored in a database **within** the mobile phone. See, specification at page 1, lines 4-8. Under the present invention, a mobile phone is referred to as a mobile communication unit. See, specification at page 1, line 6. The present invention discloses a mobile communication unit 10 that includes a database 12 for storage of data records for one or more telephone numbers, with each data record containing a stored character string representing a name of a party corresponding to each phone number stored in the database. See, specification at page 6, lines 20-24.

The present invention further discloses automatically switching to a manual entry mode if the locally stored directory number is not found in the database 12. See, specification figures 2 and 4. Figures 4 and 5 in the present invention further illustrate how the mobile communication unit 10 automatically reverts to normal phone entry mode when no entry in the database could potentially match the desired character string. See, specification at page 11, lines 13-17.

Specifically, claim 1 recites a searching step for accessing a database within a mobile phone and an automatically switching step that will allow the operator to manually enter a phone number when a desired character string cannot be found in the database.

Independent claims 1, 8, 19, and 29 have been amended to further clarify what happens once the mobile phone is automatically switched to the normal dialing mode of operation. Specifically, additional digits can be entered and will be appended to the desired character string without having to re-start the dialing process.

The steps described in the claims of the present invention can be characterized as pre-call activity, i.e., activity that occurs prior to attempting to connect to a mobile network.

The Examiner has rejected claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,442,470 to Simon et al. (hereinafter, Simon), in view of U.S. Patent No. 6,222,917 to Gates (hereinafter, Gates).

Regarding claim 1, the Examiner states that Simon teaches a method for operating a mobile communication unit having a database containing data records for one or more telephone numbers with each data record containing an index item stored by a character string. The

Examiner adds that the method further includes searching the database for an index item beginning with a desired character string. The Examiner acknowledges, however, that Simon fails to teach a method of automatically switching the mobile communication unit to a normal telephone number entry mode, if the database contains no data records having an index potentially matching the desired character string.

The Examiner then states that Gates teaches a method in which if dialed digits for a candidate directory number entered by a calling party do not match with any directory number listed in a database, the *system* conventionally attempts a call to a called party using the digits entered by the calling party. The Examiner then summarily states that, integrating Gates' teachings into the communication system of Simon would have been obvious for fast completing the call.

Applicant respectfully submits that the cited references do not suggest the presently claimed invention, either singly or taken in any reasonable combination. The Examiner has mis-characterized the teachings of Gates as applied to the present invention. Simon relates to individual mobile phones, specifically looking up and calling telephone numbers which have been stored in a telephone or associated device. See, Simon at column 1, in the "technical field" section. Gates, however, relates to a method and apparatus for providing a *directory number* to a *call processing device* in a communication network. See, Gates at column 1, in the "field of invention" section (emphasis added). Applicant respectfully submits that it would not have been obvious to one skilled in the art to combine Simon and Gates since the two references are not in the same art.

In Gates, a *directory number* is defined as a series of one or more digits, such as a telephone number, that is associated with a particular customer identity in a communications network. The number usually relates to a particular terminal within the communications network. For example, the directory number could be a telephone number associated with a particular telephone or fax machine. See, Gates at Column 1, lines 13-20.

In Gates, the phrase *call-processing device* is referred to as any function or component that is arranged to accept at least part of a directory number. See, Gates at Column 6, lines 51-53. The call-processing device disclosed in Gates refers to the infrastructure or network equipment that routes a call after the directory number is dialed, such as a mobile switch. See, Gates at Column 5, lines 1-2. Gates does **not** refer to a device such as a mobile phone that is

used to initiate a call by dialing a directory number. Simon does refer to a device that can be used to initiate a call by dialing a directory number. Therefore, it would not have been obvious to adapt network equipment technology (i.e., Gates) into a mobile phone (i.e., Simon) since the platforms and processing equipment for each are separate and distinct from one another.

The purpose of Gates is to connect a calling party, who dials a directory number, with a called party via a telecommunications infrastructure. Figure 1, in Gates, discloses the method for connecting a calling party, who has dialed a directory number, with a called party. A digit collector 2 is provided which collects dialed digits from a terminal 1. These collected digits form a candidate directory number. Also provided is a list of stored directory numbers and means for searching this list. The digit collector 2 and the list 3 together form apparatus 6 for providing a complete directory number to the call process. This process can be integrated into the switch 4 or alternatively may be a separate entity. See, Gates at column 7, lines 21-31.

In Gates, when the dialed number is not found 35 in the candidate directory list (which is not stored within the mobile communication unit), the apparatus or system "waits" for the time out period. If more digits are dialed 37, then the process returns to box 31 as indicated by the arrow between boxes 37 and 31 in Fig. 3. If the time out elapses or the send key is pressed, then a call attempt is made using the dialed number (see figure 3 -box 38). See, Gates at column 8, lines 18-23. There is no automatic switching of modes of operation in a mobile phone between a database look-up mode and a manual mode because the disclosure in Gates is not intended or adaptable to a mobile phone.

It would not have been obvious to one skilled in the art to combine Simon and Gates since the two references are not in the same art. Moreover, it is, in all probability, not even possible to incorporate the teachings of Gates into the system of Simon since Gates' teachings require intimate knowledge of and communication with network infrastructure elements that Simon has absolutely no access to or knowledge of.

Due to Applicant's belief that the Gates reference has been mis-characterized by the Examiner, Applicants respectfully request reconsideration and withdrawal of the 35 USC 103(a) rejections of claims 1-29 based on the Simon/Gates combination.
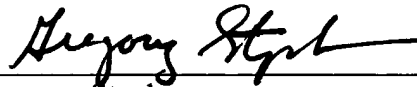
CONCLUSION

For the reasons set forth above, the applicants believe the claims of the present application are in condition for allowance, which action is respectfully requested.

Applicant believes there are no additional charges; however, the Director is authorized to charge any additional fees or underpayments to Deposit Account No. 13-4365.

Respectfully submitted,

For the applicant,

Date: 2/23/05

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